REMARKS

In response to the Office Action dated August 13, 2003, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-45 are pending in the present application. Applicants gratefully acknowledge the Examiner's indication that claims 18-20 and 40-42 would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-6, 10, 16-17, 21-28, 32, 38-39 and 43-45 were rejected under 35 U.S.C. § 102(e) as being as being anticipated by Win et al., U.S. Patent 6,453,353 (hereinafter "Win") for the reasons stated on the pages 2-4 of the Office Action.

In claim 1, the data file requested by a requester is specified with at least one data format, and the requested data file is translated into the requested data format if the requested data format is different from the data format stored in a data repository, thereby providing a requester with the requested data file in the requested data format.

The profile information of a user in Win simply comprises the user's name, locate information, IP address, and information defining roles held by the user, but not the data format (col. 10, lines 49-51 of Win). Thus, the personalized menu is returned to the browser in the form of a Web page or HTML document, which is determined by HTML template stored in an Access Server, rather than the profile information of the user (col. 12, lines 3-8 of Win). Further, there is no disclosure or teaching that the Web page or HTML document is the requested data format by the user. Thus, Win neither discloses nor teaches

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the limitations: receiving a request for a data file from a requester said request specifying at least one data format; and translating the requested data file from a stored data format into said requested data format responsive to said receiving of said request from said requester, if said stored format differs from said requested format, as claimed in claim 1. Accordingly, Win does not anticipate or render obvious claim 1.

Claims 23 and 45 are believed to be patentable over Win for at least the reasons given for claim 1. Claims 2-6, 10, 16-17 and 21-22 depend from claim 1, and claims 24-28, 32, 38-39 and 43-44 depend from claim 23. Applicants respectfully request reconsideration of the outstanding rejections.

Claim Rejections Under 35 U.S.C. § 103

Claims 7-9, 11-15, 29-31 and 33-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Win for the reasons stated on pages 4-6 of the Office Action. Applicants respectfully disagree.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

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Applicants' claim 7 recites a repository residing behind a secure firewall and a translated data file retained at a response repository located outside of the firewall in response to a request to do so. Winn discloses a protected server that gives authorized users access to specified information and resources. Nothing in the Winn reference teaches or suggests data format translation capabilities and a response repository for storing same outside of a secure firewall. Therefore, there is no motivation to combine the Applicants' invention with the Winn reference with respect to Applicants' claim 7. Because Winn does not teach nor disclose each element of the invention it cannot render the Applicant's claims unpatentable. For at least these reasons, it is respectfully requested that the rejection of claim 7 be withdrawn.

Alternatively, assuming for the sake of argument, that the cited reference is applicable, Applicant respectfully maintains that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, by failing to provide any motivation for the suggested combination. "(E)ven assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

The explanation provided in the Office Action in this instance provides no justification or explanation for the suggested combination of the cited references. The rejection based on the suggested combination of references merely amounts to a compilation of the claimed elements without any suggestion or motivation for their combination. There are no teachings in the art or the cited references that would have motivated one skilled in the art to make the suggested combination. The cited reference is drawn to addressing very different concerns than the Applicants' invention (e.g., Winn is

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directed to providing an access permissions structure for managing a computer network (see generally Abstract). The Applicants' invention addresses a means for providing access to a repository of formatted data files and allows a user to request initiated translation that is governed by a rules-based translation service. Support may be found generally in Applicants' Abstract. Therefore, the Examiner has not made a prima facie case for obviousness under §103(a). Thus, Claims 7-9, 11-15, 29-31, 33-37 are allowable, the rejections are improper, and they should be withdrawn.

Moreover, Applicants respectfully maintain that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, based on improper hindsight which fails to consider the totality of Applicants' invention and to the totality of the cited references. More specifically, the Examiner has used Applicants' disclosure to select portions of the cited references to allegedly arrive at Applicants' invention. In doing so, the Examiner has failed to consider the teachings of the reference or Applicants' invention as a whole in contravention of section 103.

As described above, Win does not teach all the limitations of claims 1 and 23. Thus, Win does not render obvious claims 1 and 23. Claims 7-9 and 11-15 depend from claim 1, and claims 29-31 and 33-37 depend from claim 23.

Conclusion

No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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